



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,787	08/04/2003	David S. Benco	LUTZ 2 00231	6929

7590 07/21/2005

Richard J. Minnich
Fay, Sharpe, Fagan, Minnich & McKee, LLP
Seventh Floor
1100 Superior Avenue
Cleveland, OH 44114

EXAMINER

LE, DANH C

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,787

Applicant(s)

BENCO ET AL.

Examiner

DANH C. LE

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-13, 15-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 8, 14 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

- 1. Claims 1-7, 9-13, 15-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (US 2003/0083067) in view of Nickum (US 2004/0063422).**

As to claim 1, Hanson teaches a method for monitoring a roaming charge rate on a mobile station (figure 2), the mobile station being associated with a wireless network and a subscriber to wireless services from a wireless service provider associated with the wireless network the method including the steps:

Art Unit: 2683

a) while the mobile station is located in a current geographic area, determining if the mobile station is roaming;

b) determining if a roaming charge will be incurred by the subscriber when using the mobile station in the current geographic area; and

c) communicating a roaming charge rate associated with the roaming charge that would be incurred to the mobile station (paragraph 0057).

Hanson fails to teach the roaming charge rate is displayed on a display associated with the mobile station while the mobile station is located in the current geographic area.

Nickum teaches the roaming charge rate is displayed on a display associated with the mobile station while the mobile station is located in the current geographic area (paragraph 0033). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Nickum into the system of Hanson in order to allow use conditions to be better determined.

As to claim 2, the combination of Hanson and Nickum teaches the method as set forth in claim 1, between steps a) and b), the method further including:

retrieving at least a portion of an existing service plan between the subscriber and the wireless service provider from a subscriber database (figure 2, 122).

As to claim 3, the combination of Hanson and Nickum teaches method as set forth in claim 2 wherein the retrieved portion includes a roaming charge rate associated with the current geographic area (paragraph 0048).

Art Unit: 2683

As to claim 4, the combination of Hanson and Nickum teaches method as set forth in claim 1 wherein the roaming charge rate is a per-minute charge rate (paragraph 0019).

As to claim 5, the combination of Hanson and Nickum teaches method as set forth in claim 1 (figure 2), further including:

d) while the mobile station is located in a different geographic area, determining the mobile station is roaming; and

e) repeating steps b) and c) for the different geographic area while the mobile station is powered up.

As to claim 6, the combination of Hanson and Nickum teaches method as set forth in claim 5 (figure 2), between steps a) and b), the method further including:

retrieving at least a portion of an existing service plan between the subscriber and the wireless service provider from a subscriber database.

As to claim 7, the combination of Hanson and Nickum teaches method as set forth in claim 6 wherein the retrieved portion includes a roaming charge rate associated with the current geographic area (Nickum, paragraph 0028, 0029).

As to claim 9, the combination of Hanson and Nickum teaches method as set forth in claim 8 wherein the cue is at least one of an audible cue, an indicator cue, and a vibratory cue (Nickum, paragraph 0029).

As to claim 10, Hanson teaches the method as set forth in claim 8, the combination of Hanson and Nickum fails to teach the cue is provided for a predetermined time period. However, the examiner takes Official Notice that the cue is

Art Unit: 2683

provided for a predetermined time period are known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of cue is provide for a predetermined time period into the system of Hanson and Nickum in order to allow use conditions to be better determined.

As to claim 11, Hanson teaches the method as set forth in claim 5 wherein the roaming charge rate is a per-minute charge rate (paragraph 0019).

As to claim 12, Hanson teaches the method for monitoring a per-minute roaming charge on a mobile station (figure 2), the mobile station being associated with a wireless network and a subscriber to wireless services from a wireless service provider associated with the wireless network, the method including the steps:

- a) while the mobile station is located in a current geographic area, determining the mobile station is roaming;
- b) retrieving at least a portion of an existing service plan between the subscriber and the wireless service provider from a subscriber database;
- c) determining a per-minute roaming charge will be incurred by the subscriber when using the mobile station in the current geographic area;
- d) communicating the per-minute roaming charge to the home MSC;
- e) while the mobile station is located in a different geographic area, determining the mobile station is roaming; and
- g) repeating steps b) - e) for the different geographic area while the mobile station is powered up.

Art Unit: 2683

Hanson fails to teach displaying the per-minute roaming charge on a display associated with the mobile station while the mobile station is located in the current geographic area. Nickum teaches displaying the per-minute roaming charge on a display associated with the mobile station while the mobile station is located in the current geographic area (paragraph 0033). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Nickum into the system of Hanson in order to allow use conditions to be better determined.

As to claim 13, the combination of Hanson and Nickum teaches the method as set forth in claim 12 wherein the retrieved portion includes a roaming charge rate associated with the current geographic area (Nickum, paragraph 0028).

As to claim 15, the combination of Hanson and Nickum teaches the method as set forth in claim 14 wherein the cue is at least one of an audible cue, an indicator cue, and a vibratory cue (paragraph 0029).

As to claim 16, the limitation of the claim is the same limitation of claim 10; therefore, the claim is interpreted and rejected as set forth as claim 10.

As to claim 17, the claim is a system claim of claim 12; therefore, the claim is interpreted and rejected as set forth as claim 12.

As to claim 18, the claim is a system claim of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 20, the claim is a system claim of claim 15; therefore, the claim is interpreted and rejected as set forth as claim 15.

Allowable Subject Matter

Claims 8, 14 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 8, 14, 19, the combination of Hanson and Nickum either alone or in combine fails to teach providing a cue to a user associated with the mobile station indicating a new roaming charge rate is displayed on the mobile station.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Himelhoch (US 2005/0032505) teaches calling plan time display and method of display for a cellular phone.

B. Hicks et al (US 2004/0203744) teaches system and method for home network determination in a mobile phone.

C. McGregor et al (US 2004/0097220) teaches mobile phone with internal accounting.

D. Reed (US 2005/0113113) teaches enhanced wireless phone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C. LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

Art Unit: 2683

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Danh", is written over a horizontal line.

July 12, 2005.

DANH CONG LE
PATENT EXAMINER